



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/510,031

12/09/2004

Yuko Tachibana

Q83945

4662

23373

7590

11/02/2006

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

MAYO III, WILLIAM H

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/510,031

Applicant(s)

TACHIBANA ET AL.

Examiner

William H. Mayo III

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7, 8, 11, 13 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7-8, 11, 13, and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 2, 2006 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 are rejected under 35 U.S.C. 102(b) as being anticipated by Asakura et al (Pat Num 5,808,260, herein referred to as Asakura). Asakura discloses a cable connection method (Figs 1-10) for connecting an end of a conductor (3a) of a cable (3) to the connecting face (A) of a contact member (2a) of a connector (2) such that the lengthwise direction of the connecting face (A) and the lengthwise direction of the conductor (3) are mutually matched in the connection (Fig 1). Specifically, with respect to claim 1, Asakura discloses a method wherein the cable (3) has an conductor end (3a)

Art Unit: 2831

which is pressurized against said connecting face (A) by a pair of electrodes (8 & 9) mutually separated in the lengthwise direction (top to bottom) of said conductor (3a) and an electric current is passed between said pair of electrodes (8 & 9), welding said end of said cable (3a) and said connecting face (A) of the connector (2) together (Col 4, lines 45-62), wherein a part (3a) of the conductor (3) that comes into contact with the connecting face (A) of the contact (2) is formed as a flat surface and the part of the conductor (3) that comes into contact with the electrodes (8 & 9) is formed on as a flat surface (Fig 1). With respect to claim 11, Asakura discloses a cable welding device (8 & 9) for connecting an end of a conductor (3a) of a cable (3) to the connecting face (A) of a contact member (2a) of a connector (2) such that the lengthwise direction of the connecting face (A) and the lengthwise direction of the conductor (3) are mutually matched in the connection (Fig 1) comprising a base (not numbered) on which the connector (2) furnishing the contact (2a) is disposed, a pair of electrodes (8 & 9) mutually separated in the) lengthwise direction (top to bottom) of the conductor (2), pressure means (10) capable of pressing the pair of electrodes (8 & 9) to pressure the end (3a) of the conductor (3) against the connecting face (A) and a voltage applying means (23) capable of applying a voltage between the electrodes (6 & 7, Fig 1).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 7, 11, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asakura (Pat Num 5,808,260). Asakura discloses a cable connection method (Figs 1-10) for connecting an end of a conductor (3a) of a cable (3) to the connecting face (A) of a contact member (2a) of a connector (2) such that the lengthwise direction of the connecting face (A) and the lengthwise direction of the conductor (3) are mutually matched in the connection (Fig 1). Specifically, with respect to claim 7, Asakura discloses a method wherein the cable (3) has an conductor end (3a) which is pressurized against said connecting face (A) by a pair of electrodes (8 & 9) mutually separated in the lengthwise direction (top to bottom) of said conductor (3a) and an electric current is passed between said pair of electrodes (8 & 9), welding said end of said cable (3a) and said connecting face (A) of the connector (2) together (Col 4, lines 45-62), wherein the state of the welding is within the scope in which a depth at the top of the color change part forming the arc (bottom electrode) on the contact (2) is above a

Art Unit: 2831

distance to the condition immediately prior to blasting the contact (2), wherein a part (3a) of the conductor (3) that comes into contact with the connecting face (A) of the contact (2) is formed as a flat surface and the part of the conductor (3) that comes into contact with the electrodes (8 & 9) is formed on as a flat surface (Fig 1).

However, Asakura doesn't necessarily disclose the distance being 0.1mm (claim 7).

With respect to claim 7, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the distance of Asakura to comprise the state of the welding is within the scope in which a depth at the top of the color change part forming the arc on the contact is above a distance of 0.1mm to the condition immediately prior to blasting the contact, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Asakura also discloses a cable connection method (Figs 1-10) for connecting an end of a conductor (3a) of a cable (3) to the connecting face (A) of a contact member (2a) of a connector (2) such that the lengthwise direction of the connecting face (A) and the lengthwise direction of the conductor (3) are mutually matched in the connection (Fig 1). Specifically, with respect to claim 11, Asakura discloses a cable welding device (8 & 9) for connecting an end of a conductor (3a) of a cable (3) to the connecting face (A) of a contact member (2a) of a connector (2) such that the lengthwise direction of the connecting face (A) and the lengthwise direction of the conductor (3) are mutually matched in the connection (Fig 1) comprising a base (not numbered) on which the

Art Unit: 2831

connector (2) furnishing the contact (2a) is disposed, a pair of electrodes (8 & 9) mutually separated in the) lengthwise direction (top to bottom) of the conductor (2), pressure means (10) capable of pressing the pair of electrodes (8 & 9) to pressure the end (3a) of the conductor (3) against the connecting face (A) and a voltage applying means (23) capable of applying a voltage between the electrodes (6 & 7, Fig 1), wherein a plurality of contacts (2a) and an end (3a) of the conductor (3) comprising a pair of electrodes (8 & 9) moving a position to enable the contacts (2a) to be welded and pressured (Col 4, lines 45-62).

However, Asakura doesn't disclose the conductor being a plurality of groupings of the conductors (claim 11).

With respect to claim 11, it would have been obvious to one having ordinary skill in the art, at the time the invention was made to modify the conductor of Asakura to comprise a plurality of groupings of conductors, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. (*St. Regis Paper Co v. Bemis Co.*, 193 USPQ 8).

Asakura discloses a cable connection method (Figs 1-10) for connecting an end of a conductor (3a) of a cable (3) to the connecting face (A) of a contact member (2a) of a connector (2) such that the lengthwise direction of the connecting face (A) and the lengthwise direction of the conductor (3) are mutually matched in the connection (Fig 1) as disclosed with respect to claim 1 above. Specifically, with respect to claim 18, Asakura discloses that the welding is within the scope in which a depth at the top of the

Art Unit: 2831

color change part forming the arc (bottom electrode) on the contact (2) is above a distance to the condition immediately prior to blasting the contact (2).

However, Asakura also doesn't necessarily disclose the distance being 0.1mm (claim 18).

With respect to claim 18, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the distance of Asakura to comprise the state of the welding is within the scope in which a depth at the top of the color change part forming the arc on the contact is above a distance of 0.1mm to the condition immediately prior to blasting the contact, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

7. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asakura (Pat Num 5,808,260) in view of Japanese Patent (JP 60-50079, herein referred to as JP). Asakura discloses a cable connection method (Figs 1-10) for connecting an end of a conductor (3a) of a cable (3) to the connecting face (A) of a contact member (2a) of a connector (2) such that the lengthwise direction of the connecting face (A) and the lengthwise direction of the conductor (3) are mutually matched in the connection (Fig 1). Specifically, with respect to claim 8, Asakura discloses a method wherein the cable (3) has an conductor end (3a) which is pressurized against said connecting face (A) by a pair of electrodes (8 & 9) mutually separated in the lengthwise direction (top to bottom) of said conductor (3a) and an electric current is passed between said pair of electrodes (8 & 9), welding said end of said cable (3a) and said connecting face (A) of

Art Unit: 2831

the connector (2) together (Col 4, lines 45-62), wherein the state of the welding is within the scope in which a depth at the top of the color change part forming the arc (bottom electrode) on the contact (2) is above a distance to the condition immediately prior to blasting the contact (2), wherein a part (3a) of the conductor (3) that comes into contact with the connecting face (A) of the contact (2) is formed as a flat surface and the part of the conductor (3) that comes into contact with the electrodes (8 & 9) is formed on as a flat surface (Fig 1).

However, Asakura doesn't specifically disclose the welding step comprising the dispersion of a layer of precious metal thinly covering the surface of the conductor of the cable (claim 8).

JP teaches a cable connection (Fig 1), wherein Au is utilized as a brazing filler metal to coat the conductor (1) to form an alloy layer, for the purpose of forming a strong soldering layer for bonding to another conductor (abstract).

With respect to claim 8, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the conductor wires of Asakura to comprise the AU solder layer configuration as taught by JP because JP teaches that such a configuration provides a strong soldering layer for bonding to another conductor (abstract).

Asakura also doesn't necessarily disclose the distance being 5 μm (claim 8).

With respect to claim 8, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the distance of Asakura to comprise the state of the welding is within the scope in which a depth at the top of the

Art Unit: 2831

color change part forming the arc on the contact is above a distance of 5 μm to the condition immediately prior to blasting the contact, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Asakura also discloses a cable connection method (Figs 1-10) for connecting an end of a conductor (3a) of a cable (3) to the connecting face (A) of a contact member (2a) of a connector (2) such that the lengthwise direction of the connecting face (A) and the lengthwise direction of the conductor (3) are mutually matched in the connection (Fig 1) as disclosed with respect to claim 1 above.

Asakura doesn't specifically disclose the welding step comprising the dispersion of a layer of precious metal thinly covering the surface of the conductor of the cable (claim 19).

JP teaches a cable connection (Fig 1), wherein Au is utilized as a brazing filler metal to coat the conductor (1) to form an alloy layer, for the purpose of forming a strong soldering layer for bonding to another conductor (abstract).

With respect to claim 19, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the conductor wires of Asakura to comprise the AU solder layer configuration as taught by JP because JP teaches that such a configuration provides a strong soldering layer for bonding to another conductor (abstract).

Asakura also doesn't necessarily disclose the distance being 5 μm (claim 19).

With respect to claim 19, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the distance of Asakura to comprise the state of the welding is within the scope in which a depth at the top of the color change part forming the arc on the contact is above a distance of 5 μm to the condition immediately prior to blasting the contact, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

8. Claims 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozai (Pub Num 2003/0065625) in view of Asakura (Pat Num 5,808,260). Ozai discloses an electrical connector assembly for connecting a plurality of coaxial cables to a flat cable (purpose). Specifically, with respect to claim 13, Ozai discloses that a cable (1) comprising a connector (1) including a base (3) having a plurality of conductor contacts (4 & 5) on a surface of the base (3), comprising a plurality of signal contacts (4) and a plurality of ground contacts (5), wherein the individual ground contacts (5) are arranged between adjacent pairs of adjacent signal contacts (4), a cable main body (6) comprising a plurality of wire conductors (not numbered) that connect to the plurality of contacts (4 & 5), wherein the wire conductors (not numbered) and the contacts (4 & 5) are mutually and electrically connected (Page 1, paragraph 5). With respect to claim 20, Ozai discloses that the welding is within the scope in which a depth at the top of the color change part forming the arc (bottom electrode) on the contact (2) is above a distance to the condition immediately prior to blasting the contact (2).

However, Ozai doesn't necessarily disclose the wire conductors and each of the contacts being mutually and electrically connected by welding, wherein the wire conductors have a flat surface in contact with the respective contacts (claim 13).

Asakura teaches a cable connection method (Figs 1-10) for connecting an end of a conductor (3a) of a cable (3) to the connecting face (A) of a contact member (2a) of a connector (2) such that the lengthwise direction of the connecting face (A) and the lengthwise direction of the conductor (3) are mutually matched in the connection (Fig 1), which prevents damage due to heat and provides a strong metallic connection between the conductor and connector (Col 2, lines 17-22). Specifically, with respect to claim 13, Asakura teaches a method wherein the cable (3) has an conductor end (3a) which is pressurized against said connecting face (A) by a pair of electrodes (8 & 9) mutually separated in the lengthwise direction (top to bottom) of said conductor (3a) and an electric current is passed between said pair of electrodes (8 & 9), welding said end of said cable (3a) and said connecting face (A) of the connector (2) together (Col 4, lines 45-62), wherein a part (3a) of the conductor (3) that comes into contact with the connecting face (A) of the contact (2) is formed as a flat surface and the part of the conductor (3) that comes into contact with the electrodes (8 & 9) is formed on as a flat surface (Fig 1).

With respect to claim 13, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the connection of Ozai to utilize the welding method which results in the flat conductor configuration as taught by Asakura because Asakura teaches that such a configuration prevents damage due

Art Unit: 2831

to heat and provides a strong metallic connection between the conductor and connector (Col 2, lines 17-22) and since it has been held that a change in form cannot sustain patentability where involved is only extended application of obvious attributes from a prior art. *In re Span-Deck Inc. vs. Fab-Con Inc. (CA 8, 1982) 215 USPQ 835.*

Modified Ozai also doesn't necessarily disclose the distance being 0.1mm (claim 20).

With respect to claim 20, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the distance of Asakura to comprise the state of the welding is within the scope in which a depth at the top of the color change part forming the arc on the contact is above a distance of 0.1mm to the condition immediately prior to blasting the contact, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).*

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozai (Pub Num 2003/0065625) in view of Asakura (Pat Num 5,808,260, herein referred to as modified Ozai), as applied to claim 13 above, further in view of Japanese Patent (JP 60-50079, herein referred to as JP). Modified Ozai discloses an electrical connector assembly for connecting a plurality of coaxial cables to a flat cable (purpose).

However, modified Ozai doesn't specifically disclose the welding step comprising the dispersion of a layer of precious metal thinly covering the surface of the conductor of the cable (claim 21).

JP teaches a cable connection (Fig 1), wherein Au is utilized as a brazing filler metal to coat the conductor (1) to form an alloy layer, for the purpose of forming a strong soldering layer for bonding to another conductor (abstract).

With respect to claim 21, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the conductor wires of modified Ozai to comprise the AU solder layer configuration as taught by JP because JP teaches that such a configuration provides a strong soldering layer for bonding to another conductor (abstract).

Ozai also doesn't necessarily disclose the distance being 5 μm (claim 21).

With respect to claim 21, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the distance of modified Ozai to comprise the state of the welding is within the scope in which a depth at the top of the color change part forming the arc on the contact is above a distance of 5 μm to the condition immediately prior to blasting the contact, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

10. Applicant's arguments filed September 1, 2006 have been fully considered but they are not persuasive. Specifically, the applicant argues the following as they may apply to the rejection of the dependent claims:

Art Unit: 2831

- A) Asakura doesn't teach or disclose a part of the conductor being flat when in contact with the contacts and electrodes but rather a circular cross section and therefore doesn't anticipate or render the claims obvious.
- B) The electrodes of Asakura are not capable of welding a plurality of groupings of conductors and contacts at the same time.

With respect to argument A, the examiner respectfully traverses. As stated previously, Asakura clearly discloses that the connecting terminal and the conductor are crimped the same as described in the prior art. Specifically, Asakura states in Column 4, lines 10-16

"As shown in Fig 2, a core portion 3a of the electric wire 3 is crimped into a caulking portion 2a of the connecting terminal 2 before resistive welding by both electrodes 6, 7. This crimping method is the same as described in connection with the prior art. Specifically, for example, by using the pressurized tool 107 in the apparatus shown in Figs 5-7, the core wire portion 3a of the electric wire 3 is crimped into the caulking portion 2a of the connecting terminal 2."

While the examiner believes that Figure 2 of Asakura clearly discloses the conductors being flat after compression, clearly Figures 5-7 show that the round conductors of the prior art are compressed thereby causing them to become flatten as shown in Figures 6-7. As a matter of fact, the cross section of the conductors shown in Figures 6-7 is in a more flatten state than that as illustrated by the applicant in Figures 8 & 12. Asakura clearly teaches that the conductors are crimped as shown in the prior art and therefore

Art Unit: 2831

the conductors of Asakura are in a flatten state. MPEP 608 teaches that drawings must be evaluated for what they reasonably disclose. Specifically, it has been held that the drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. In re Aslanian, 590 F. 2d 911, 200 USPQ 500 (CCPA 1979). In light of the above comments, the examiner respectfully submits that the 35 USC 102(b) rejection is proper and just.

With respect to argument B, the examiner respectfully traverses. Clearly, Asakura discloses a crimping terminal (2) comprising a plurality of contacts (left and right contacts 2a) and an end (3a) of the conductor (3) comprising a plurality of single conductors (i.e. strands of conductors) that are grouped (left half of strands and right half of strands), wherein a pair of electrodes (8 & 9) are moved in a position to enable the contacts (left and right 2a) to be welded and pressured (Col 4, lines 45-62) around the grouping of conductors (left and right halves of strands). Specifically, a plurality of contacts (left and right 2a) surround a plurality of groupings of conductors (left and right contacts 2a surround left and right grouping of conductor strands (3a) and are resistive welded by a plurality of electrodes (8 & 9, see Figure 4 of 260' reference). While the applicant has referred to examiner attention to Figure 4 of the claimed invention, the examiner is required to give the claims their broadest reasonable interpretation and cannot rely on the drawings for such an interpretation. Specifically, the MPEP instructs the examiner as stated below:

2111 [R-1] Claim Interpretation; Broadest Reasonable Interpretation

CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given *>their< broadest

reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).< Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (Claim 9 was directed to a process of analyzing data generated by mass spectrographic analysis of a gas. The process comprised selecting the data to be analyzed by subjecting the data to a mathematical manipulation. The examiner made rejections under 35 U.S.C. 101 and 102. In the 35 U.S.C. 102 rejection, the examiner explained that the claim was anticipated by a mental process augmented by pencil and paper markings. The court agreed that the claim was not limited to using a machine to carry out the process since the claim did not explicitly set forth the machine. The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.").

Art Unit: 2831

Given the above guidelines, the examiner respectfully submits that the 35 USC 102(b) rejection is proper and just. If the applicant intends to claim the structure of Figure 4, then he/she should recite specific structure of the Figure to overcome the interpretation of Figure 4 of Asakura.

Communication

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/510,031
Art Unit: 2831

Page 18

A handwritten signature in black ink, appearing to read 'William H. Mayo III', written over a circular stamp.

William H. Mayo III
Primary Examiner
Art Unit 2831

WHM III
October 27, 2006